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Applicant:

Schreiber et al.

Examiner:

Solola, Taofiq A.

Serial No.:

10/649,532

Art Unit:

1639

Filing Date:

August 27, 2003

Title:

DIHYDROPYRANCARBOXAMIDES AND USES THEREOF

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Commissioner for Patents

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Sir:

DECLARATION UNDER 37 C.F.R. 1.131

I, Robert A. Stavenger, Ph.D., declare as follows:

- 1. I am an inventor of the subject matter disclosed and claimed in United States Patent Application Serial No. 10/649,532 ('532 application) filed August 27, 2003, and entitled "DIHYDROPYRANCARBOXAMIDES AND USES THEREOF". This application claims priority to United States provisional patent application Serial No. 60/406,140, filed on August 27, 2002.
- 2. This Declaration is presented for the purpose of removing from consideration by the Examiner the following two papers:
- (i) Clemons et al. "A one-bead, one-stock solution approach to chemical genetics: part 2", Chem. Biol. 8:1183-1195, 2001 (hereinafter, "Clemons"). As indicated on the front page of the paper, the article first published online on November 7, 2001. Thus, the paper first became available to the public on November 7, 2001.
- (ii) Blackwell et al. "Decoding Products of Diversity Pathways from Stock Solutions Derived from Single Polymeric Macrobeads", Angew. Chem. Int. Ed. 40(18):3421-3425, 2001 (hereinafter, "Blackwell"). The paper first became available to the public on September 14, 2001.

Therefore, both the Clemons and Blackwell papers became available to the public less than one year prior to the filing of the provisional application to which the present application claims priority.

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The present Declaration is presented in accordance with <u>In re Stompel</u>, 113 U.S.P.Q. 77 (CCPA 1957) and establishes conception and reduction to practice of the invention in this country before September 14, 2001.

- 3. While the publication date of the edition of Angewandte Chemie International Edition in which Blackwell appeared was September 17, 2001, the article was first published online on September 14, 2001 as indicated in the print out of the Journal's web page (Exhibit 1, page 5).
- 4. The inventors of the claimed subject matter of United States Patent Application Serial No. 10/649,532 are Stuart L. Schreiber, Robert A. Stavenger, Timothy J. Mitchison, and Zoltan Maliga.
- 5. On a date before September 14, 2001, Stuart L. Schreiber, Timothy J. Mitchison, and Zoltan Maliga and I conceived and reduced to practice our invention of dihydropyrancarboxamide compounds and uses thereof.
- Exhibit 2 is a copy of several pages from my laboratory notebook, with dates blacked out. Exhibit 2 provides evidence of conception and actual reduction to practice of the claimed invention prior to September 14, 2001. In particular, pages 17-20, 22-24 and 26-29 include a description of a synthesis of a library of dihydropyrancarboxamide compounds, using vinyl ether, unsaturated ketoester and amine building blocks disclosed in the specification, as filed. For example, page 17 describes vinyl ether building blocks BB1-A through BB1-H depicted on page 61 of the specification. Page 20 describes unsaturated ketoester building blocks BB2-A through BB2-J depicted on page 62 of the specification. Page 26 describes amine building blocks BB3-A through BB3-Y depicted on page 66 of the specification. Finally, pages 31-34 include a description of the decoding process of the dihydropyrancarboxamide library. The notes were prepared in the United States of America.
 - 7. The originals of these documents bear dates prior to September 14, 2001.

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All statements made herein of my own knowledge are true and that all statements 8. made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patents issued thereon.

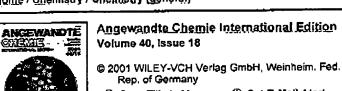
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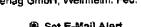
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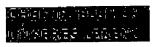
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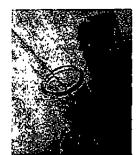


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Manuela Schweiger, S. Russell Seidel, Atta M. Arif, Peter J. Stang

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Published Online: 14 Sep 2001

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Masahisa Osawa, Mikio Hoshino, Yasuo Wakatsuki

Published Online: 14 Sep 2001

DOI: 10.1002/1521-3773(20010917)40:18<3472::AID-ANIE3472>3.0.CO;2-W

Abstract | References | Full Text: HTML, PDF (Size: 85K)

Saxe Article

The Hexaphosphapentaprismane P₆C₄tBu₄: A "Jaws-Like" Cage Molecule That Bites! (p 3474-3477)

Mahmoud M. Al-Ktaifani, Daniel P. Chapman, Matthew D. Francis, Peter B. Hitchcock, John F. Nixon,

László Nyulászi

Published Online: 14 Sep 2001

DOI: 10.1002/1521-3773(20010917)40:18<3474::AID-ANIE3474>3.0.CQ;2-K

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Book Review

Rutherford - Scientist Supreme. By John Campbell (p 3479)

Günter Herrmann

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Ulrich Panne

Published Online: 14 Sep 2001

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Chiral Catalyst Immobilization and Recycling. By Dirk E. De Vos, Ivo F. J. Vankelecom and Pierre A. Jacobs (p 3480)

Rainer Haao

Published Online: 14 Sep 2001

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Biomineralization. From Biology to Biotechnology and Medical Application. Edited by Edmund

Baeuerlein (p 3481) Mathias Epple

Published Online: 14 Sep 2001

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Burkhard Kirste

Published Online: 14 Sep 2001

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Abstract | Full Text: HTML, PDF (Size: 79K)

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15 pages

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7							
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1 /ef	nihidaicho.	1-92d	B 110mg HC	~~~	_O Mol	C ₇ H ₁₄ O ₃ . Wt.: 146.18	_
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	shaken	4h	then fil	tind an	d was	hed.	
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	1 X 5 mi	L = 10 min	THE JU	25 and ×15	min Ctt, U	<u>dri</u>	19 -
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20

,	Cycloudition:
	wing the rein + CT 3 + Cu (07f) + 4/ ms
	stock soln of cotalet - 19/mg blood - A3mg Cy (072). 150mg sleves in 12.8ml THE stored Q at the 1/h cey green color
each vial=	Ciones (see below) 19 (20 vials) added the vials contains
Plin.	+ 800 al do, THE added, followed by 800 al 1-taly of sola (20 mol Po). Vials shaken for 20 le then washed - Yusal x30 min THE, 3x5 al x Zeonis CH, Cla
11,000 - 0.45 ag	dried and moved to next if ap (pp 22-23)
22 -	C20H16O3 MO1, W1: 216.23 MO1, W1: 304.34 MO1, W1: 274.27 C13H14O3 MO1, W1: 222.26 MO1, W1: 222.26 MO1, W1: 236.23 MO1, W1: 237.31 C15H12O3 MO1, W1: 237.31 MO1, W1: 237.31 MO1, W1: 326.35 MO1, W1: 326.35 MO1, W1: 326.35
C ₁₀ 11 ₁₄ 03 Mol. WI.: 182.22 C ₁₃ 11 ₁₂ 03	Mol. Will St. 12 Mol. W

2					REST	AVAILA	BLE COPY	
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		inliba	L CH'(<u> </u>	88 110.5	<u>nol/tes</u>	tur 1 to, 120A-20E	<u>) </u>
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	sin pool	TBA (CSCIS)	T4A (C6CI5) mw 540.67	T5A (C7CIS)	T6A (C8CIS)	17A (C9CIS)		
	in pool 20A 20B	T3A (CSC15) mw 526.64	T4A (C6CI5)	T5A (C7CIS) mw 554.70	T6A (C8CIS)	17A (C9CIS)		
	20A 20B 20C	T3A (CSC15) mw 526.64	T4A (C6CI5) mw 540.67	T5A (C7CIS)	T6A (C8CIS)	17A (C9CIS)		
- 2 - 2 - 2	in pool 20A 20B	T3A (CSC15) mw 526.64	T4A (C6CI5) mw 540.67	T5A (C7CIS) mw 554.70	T6A (C8CE) mw 566.73	17A (C9CIS)		
- 2 - 2 - 1 - 2	20A 20B 20C 20D	T3A (CSC15) mw 526.64	T4A (C6CI5) mw 540.67	T5A (C7CIS) mw 554.70	T6A (C8CE) mw 566.73	T7A (C9CI5) rrw 582.76		
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	20B	V	14.5mg	6	ø	ø
	20C	8	Ø	14.9mg	ø	3
	20D	d	ø	ø	15.3mg	Ø
	20E	4	46	ø	ø	15.7mg
	20F	7.1mg	7.3mg	8	8	d
	20G	7.1mg	6	7.5mg	8	
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· · · · · · · · · · · · · · · ·	201	7.1mg	d	Ø	ø	7.9mg
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	21H	4.7mg	4.8mg	ø	Ø	5.2mg
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24	
	Making the library step 5 - Lealflation!
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	followed by throbodicyle acid + deep red mixture
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	ia 20x ool → 5/. Yang
	21 part > 5 d. J.ms
	· and proceed to next trep
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26	BEST AVAILABLE COPY
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—— • HŃ	OMe Artimophenylbenzothiazole
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	Mol. Wt.: 217.27H Wt.: 111.18 ketobenziidazole O2N 255m Tu toth 51 or bld Tu toth 51 or bld
	155 on NH2 V NN NH2 Page.
2-aminonorbo	omene 2 m 30 m aminoethylamino
	2HCI, H ₂ O W OMe 105 ms
- MeO	NH ₂
_	HN N-OOMS
methoxy trypt	aminoaniline A
-" \\\\\\\\\\\\\\\\\\\\\\\\\\\\\\\\\\\\	MH ₂ /5 3 Mol. Wt.: 220.27
Mol. W	14220 O HOH IF 15-125
aminopropyl	pyrrolldinone

BEST AVAILABLE COPY	27
16 - VI Min from "20 pool"	
•	
1609 14" mort nich 120 - 76"	
7-11 wil I win I have I CHELLID R-	
To each vial of 16sin , stack solm of CHCI. IP, for wis	
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added to ever used with some if the gain	
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shake are set (ILA)	
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high version and kept separated in tables.	
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28

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LCMS of library

Resin pool	LCMS sample	Resin pool	LCMS sample
26a	1.2	27a	51.52
26b	3, 4	27ь	53, 54
26c	5,6	27c_	55, 56
26d	7.8	27d	57, 58
26e	9, 10	27e	59, 60
26f	11, 12	27f	61, 62
26g	13. 14	27g	63. 64
26h	15, 16	27h	65, 66
261	17, 18	271	67, 68
26 j	19, 20		69, 70
26k	21,22	27k	71,72
261	23, 24	271	73.74
26m	25. 26	27m	75, 76
26n	27, 28	27n	77,78
260	29. 30	270	79, 80
26p	31, 32	27p	81, 82
264	33, 34	279	83, 84
26г	35, 36	27τ	85. 86
26s	37. 38	27s	87, 88
261	39, 40	27:	89, 90
26ს	41.42	27u .	91.92
26v	43, 44	27v	93. 94
26w	45, 46	27w	95, 96
26x	47, 48	27x	97, 98
26y	49, 50	27у	99, 100
20 cycloaddiion	101, 102	21 cycloaddiron	103, 104
20 pool (acid)			
eo puoi (acio)	105, 106	21 pool (acid)	107, 108
	l]	I

	single bade in 700,4 epperdorf to Stess,
	1 trended w/ 2 12.5 gl 85/10/5 THF/ por/ HF por
	Gr 1.5 h, then troops w/ 12.5 al mome for 20 min.
TONTING SDATO	Cuprated the solver, ablil 20 of Chen and transfered
30 plate	to entermber vial.

29

•				
	Dimo como	chouse:		
	kein pool	17951	# of body (countrd)	
	145-1-2919	58.50	339	
	PAJ-2-292c	47.2 mg	212	
	RAJ-1-2749	48.9mg	304	
	RAS-2-284c	37.9m	250	
	RAF 2-2979	38.3mg	236	
	RAS-1-197c	47.2	260	
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Lani D	eta: Hean pp de. 1st of WR is agak	
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fair	Sample # More Struction (Ly Mrs) prosty	
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	52 417.9 Ph	
	3 552.7 hf	
BJ	4 4259 be	
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	54 512.8 ?	
	5 4/59 en la al ca da	
	6 3447.4 415.9 eg fa at cardo	
(9)	55 5/2.8 hc	_
19.14	56 4569416 ch dh	
	l lun	
	.7 296.00 eg far et ce, de	
	18 402 D GA, CB OB 2	
1212	57 469.9 5/1 Ci di	
	158 445.9 4/1 ad ce	
	9 5/4.9 (2, 22	
	10 500.9 gé, co. de	
0	159 456.9 Ga Ch. db	
181.87	60 490.9 Fgb	
7	11 473.9 2/1 eb fb, ac, bd, 99	
+	12 479.9 eff	
}	61 4339 66	
1/1.18	62 614.7 he	
	<u> </u>	

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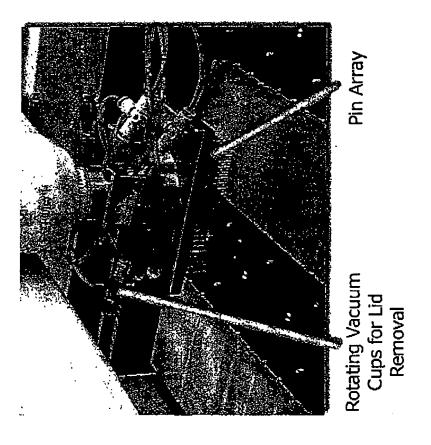
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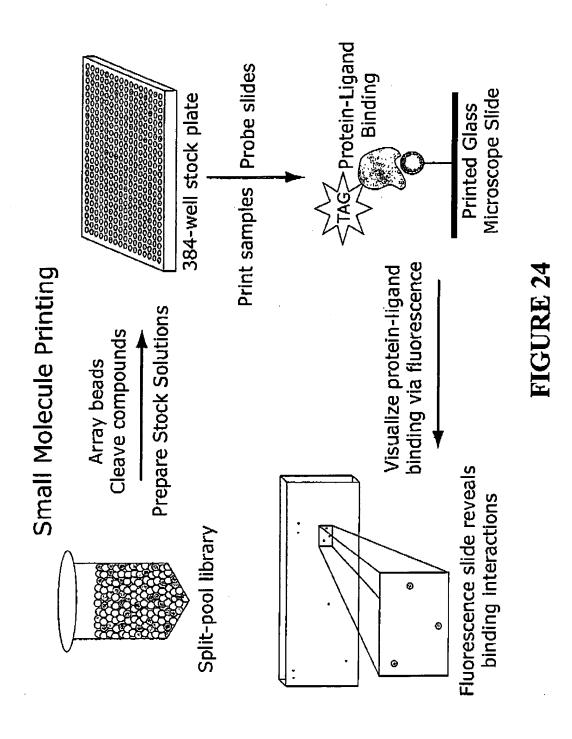
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PAGE 40/47 * RCVD AT 9/7/2006 3:27:58 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-3/3 * DNIS:2738300 * CSID:16172484000 * DURATION (mm-ss):13-36

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Small Molecule Microarraying Robot

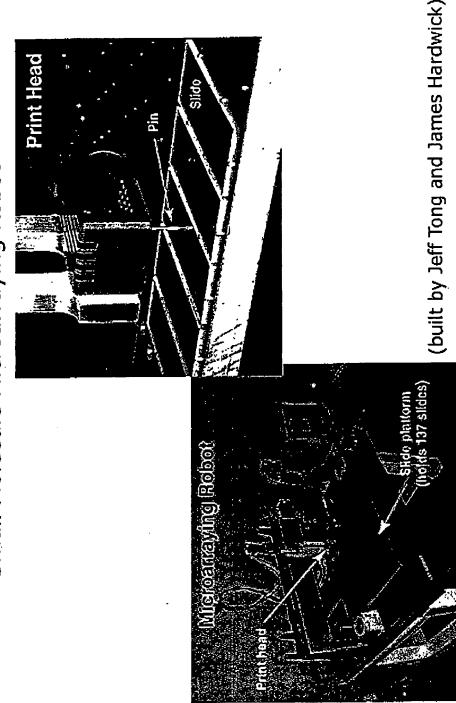


FIGURE 25